

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

5338.01-1

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Application Number

09/416,278

Filed

Oct. 14, 1999

First Named Inventor

Bradley S. Templeton

Art Unit

3623

Examiner

Beth Van Doren

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 50,250
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34
Registration number if acting under 37 CFR 1.34 _____



Signature

Steven M. Colby

Typed or printed name

650-324-1677

Telephone number

May 26, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*

☐ *Total of _____ forms are submitted.

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**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT: Bradley S. Templeton
SERIAL NO.: 09/416,278
FILING DATE: October 14, 1999
TITLE: Method and Apparatus for Intermediation of Meetings and Calls
EXAMINER: Beth Van Doren
GROUP ART UNIT: 3623
ATTY. DKT. NO.: 5338.01 (SMC)

PRE-APPEAL BRIEF

This brief is directed to the rejection of Claims 88-89 and 91 under 35 U.S.C. 102(e) as being anticipated by Gisby et al. (US 6,044,146).

1) At issue in the rejection of Claim 88-89 and 91 is whether the Examiner has made a prima facie case for the rejection under 35 U.S.C. 102(e).

Claim 88 recites:

*88. (Previously Presented) A method comprising:
transmitting or receiving a first request for a first real-time meeting between a requestor and a first target, the requestor and the first target being individuals;
determining that the first target is unavailable, using a computing system;
waiting until the first target changes from being unavailable to being available;
when the first target is available, determining if the requestor is available;
if the requestor is available, then initiating the first real-time meeting; and
if the requestor is unavailable, then waiting until a time the requestor becomes available.*

It is the position of the Applicant that the Examiner has failed to present a prima facie case for the rejection because the examiner has failed to point out a teaching of the

claim limitations “if the requester is unavailable, then waiting until a time the requestor becomes available” within the prior art.

In rejecting Claim 88, the Examiner states:

The limitation “if the requester is unavailable, then waiting until a time the requestor becomes available” does not occur in methods where the requester is available, in the previous limitations. Therefore, since Gisby et al. teaches that the requester is available, the limitation “if the requester is unavailable, then waiting until a time the requestor becomes available” is not required.

It appears that the Examiner is taking the position that because there are conditions under which a method step is not performed the Examiner is relieved of the requirement to show that step in the prior art.

The requirement that an Examiner point out a prior art teaching of every limitation in a claim is well established. See for example, MPEP § 2106.II.C which states “[w]hen evaluating the scope of a claim, every limitation in the claim must be considered.” (Diamond v. Diehr, emphasis in original) and MPEP § 2131 which states a “claim is anticipated only if each and every element as set forth in the claim is found.”

The Examiner does not cite any regulation, rule, statute or decision that would relieve her of the requirement to show a teaching of every claim element in the prior art. Specifically, the Examiner has not articulated or cited statutory support of any alternative standard for rejection under 102(e) other than those of MPEP § 2106.II.C. and MPEP § 2131 as quoted above. To the contrary, the Examiner’s position is in direct contradiction to well established case law.

First, The Applicant has previously argued that the Examiner has failed to meet the requirements of a *prima facie* case for rejection. In response the Examiner argues that there are conditions in the prior art under which particular limitations will not occur. The Applicant respectfully points out that the Examiner’s arguments are off point. It is

immaterial that under particular conditions a particular method step will not be performed in the prior art. What is material is whether the Examiner has presented a *prima facie* case for rejection. Specifically, the burden is on the Examiner to show teachings of every limitation in the prior art, NOT to show that limitations do not occur in the prior art as she has done.

Second, the Applicant points out that the claim covers not just one specific condition but several conditions. To anticipate the claim the prior art must teach all of the limitations as long as there is at least some condition under which each of the limitations serve to limit the scope of the claim. Here we have a condition of a requestor not being available, this condition may occur in various embodiments of the invention. As such, the limitations subject to this condition do function to narrow (limit) the scope of the claim and they must be taught by the prior art for the prior art to anticipate the claim.

There is no basis that allows the Examiner to pick and choose which conditions under which the claim should be considered. The fact that there are some conditions under which a method step will occur in the invention means that the Examiner must find this step in the cited art or allow the claim.

Third, assuming for the sake of argument that the Examiner is correct in her position that when there is some condition that a step is not performed, then there is no need to show the limitations of that step in rejecting a claim. This position would make all conditional claim limitations irrelevant. By their very nature a claim that includes "if X then Y" suggests that there are some conditions under which X is false. If the Examiner's position were correct, then any method step that included conditional

language could be ignored by merely pointing out the case where the condition is false. This is clearly not the case and the Examiner's position, therefore, cannot be correct.

Fourth, the fallacy of the Examiner's position can also be illustrated as follows. Consider for the sake of argument that the Applicant amended Claim 88 by removing the limitation "*if the requestor is available, then initiating the first real-time meeting.*" Claim 88 would then recite:

transmitting or receiving a first request for a first real-time meeting between a requestor and a first target, the requestor and the first target being individuals; determining that the first target is unavailable, using a computing system; waiting until the first target changes from being unavailable to being available; when the first target is available, determining if the requestor is available; and if the requestor is unavailable, then waiting until a time the requestor becomes available.

By definition this amendment would be a broadening of Claim 88 because a limitation is removed. Any teaching that anticipated the original version of Claim 88 should, therefore, also anticipate this claim. However, the Examiner's basis for ignoring the last claim element has now been eliminated. Specifically, the condition that the requestor is available is no longer part of the claim. The Examiner must, therefore, consider the last claim element, which is not taught by the cited art. The result of this logic is that a broader claim is not anticipated by the cited art while a narrow claim is anticipated. Clearly, this cannot be the case. The suggestion that the last claim element can be ignored in the original claim must, therefore, be false.

New Claims 97 and 98 have specifically been added to the application in order to better present this example on appeal.

Fifth, the Examiners statement "since Gisby et al. teaches that the requestor is available, the limitation 'if the requestor is unavailable, then waiting until a time the requestor becomes available' is not required" appears to be an express admission that the

limitations are NOT taught by the cited art. The Examiner is characterizing Gisby by pointing out that a step is not required in the prior art, e.g., it does not occur in the prior art. The Applicant respectfully points out that these arguments by the Examiner support allowability of these claims rather than their rejection.

The above arguments apply to Claim 89 and 91 as well.


The Applicant believes that all pending claims are allowable and respectfully requests that the Examiner issue a Notice of Allowance. Should the Examiner have questions, the Applicant's undersigned representative may be reached at the number provided below.

In addition, Applicant respectfully invites the Examiner to contact Applicant's representative if the Examiner believes it will help expedite furtherance of this application.

RESPECTFULLY SUBMITTED,
BRADLEY S. TEMPLETON

Date: May 26, 2008

By: _____


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